

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1, 3, 6, 8, 11, 13, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34 and 35 will have been amended and submitted for reconsideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the acknowledgment of Applicant's claim for priority under 35 U.S.C. § 119 and for confirming receipt of the certified copy of the priority document (in the parent application), as set forth in the Official Action. Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on April 1, 2004, July 6, 2004, and March 3, 2005 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

Turning to the merits of the action, the Examiner has rejected claims 1-5, 11-17, 20-23, 26-29, and 32-35 under 35 U.S.C. § 103(a) as being unpatentable over LEE et al. (U.S. Patent No. 5,742,769). The Examiner has rejected claims 6-10, 18-19, 24-25, and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over LEE et al. (U.S. Patent No. 5,742,769) in view of WEBER et al. (U.S. Patent No. 5,878,230). The Examiner has provisionally rejected claims 1-35 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of co-pending Application No. 10/767,716.

However, Applicant respectfully traverses the above rejections.

As noted above, Applicant has amended claims 1, 3, 6, 8, 11, 13, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34 and 35 and has submitted the same for reconsideration by the Examiner. Applicant respectfully traverses the above rejection based on the pending claims and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 1-21 and 34-35 generally relate to an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network. The e-mail includes a mail from command and a mail message. The image data communication apparatus includes a panel that inputs a mail address of a user to the image data communication apparatus. Further, the image data communication apparatus includes a controller configured to set the mail address of the user, input by the panel, into the mail message of the e-mail to which the image data is attached. The mail address of the user is distinct from a mail address of the image data communication apparatus. Then, the mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus. The reply is returned to the mail address of the user, but not to the mail address of the image data communication apparatus. Claims 22-33 recite related methods.

Regarding the rejection of claims 1-5, 11-17, 20-23, 26-29, and 32-35, LEE et al. relates to a system in which individual users 10 can access the directory service 25 to obtain directory information about a large number of people and businesses (col. 2,

lines 16-33). The users 10 can register basic directory information, i.e., names, addresses, and telephone numbers into the storage 30 of the directory service 25 (col. 2, lines 34-43, col. 4, lines 63-67, and col. 5, lines 1-16). The users 10 can search in the directory service 25 for the directory information of other users 10 (col. 2, lines 43-65, col. 6, lines 48-67 and col. 7, lines 1-12).

However, LEE et al. does not disclose an image data communication apparatus which sets the mail address of the user input by a panel into the mail message of the e-mail to which the image data is attached, the mail address of the user being distinct from a mail address of the image data communication apparatus, whereby the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the mail address of the user, the reply not being returned to the mail address of the image data communication apparatus.

Rather, in LEE et al., the sender sets a sender's e-mail address into a "Reply-to" field; therefore, a reply to a sending e-mail is returned to the sender that has transmitted the sending e-mail (col. 7, lines 26-63). In other words, LEE et al. merely discloses a conventional reply mail. On the other hand, the present invention recites an image data communication apparatus which transmits image data attached to an e-mail to a receiving apparatus via the network and sets the mail address of the user input by the panel into the mail message of the e-mail to which the image data is attached. The mail address of the user is distinct from a mail address of the image data communication apparatus. Thus, in the present invention, the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply

to the e-mail, the reply being sent from the receiving apparatus. The reply is returned to the mail address of the user, but is not returned to the mail address of the image data communication apparatus.

Applicant respectfully notes that he is not claiming conventional reply mail, as disclosed by LEE et al.

Thus, the pending claims are clearly distinct from LEE et al.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims are not disclosed in LEE et al. cited by the Examiner.

Regarding the rejection of claims 6-10, 18-19, 24-25, and 30-31, WEBER et al. discloses a system in which, when a user at an individual computer 12 or 30, composes an e-mail for distribution to one or more other individual computers 12 or 30, the e-mail system automatically generates a reply attribute that indicates that reply to the original message will be directed to the sender or originator.

However, WEBER et al. does not disclose an image data communication apparatus which transmits image data attached to an e-mail to a receiving apparatus via the network and sets the mail address of the user input by the panel into the mail message of the e-mail to which the image data is attached, the mail address of the user being distinct from a mail address of the image data communication apparatus, whereby the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the mail address of the user, the reply not being returned to the mail address of the image data communication apparatus.

Rather, in WEBER et al., the sender sets a sender's e-mail address into an e-mail so that reply to the original message will be directed to the sender or originator. In other words, WEBER et al. also merely discloses a conventional reply mail.

On the other hand, the present invention recites an image data communication apparatus which sets the mail address of the user input by the panel into the mail message of the e-mail to which the image data is attached. The mail address of the user is distinct from a mail address of the image data communication apparatus. Thus, in the present invention, the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus. The reply is returned to the mail address of the user, but is not returned to the mail address of the image data communication apparatus.

Thus, the pending claims are clearly distinguished over WEBER et al.

Therefore, it is respectfully submitted that the features recited in Applicant's submitted claims are not taught or disclosed in WEBER et al. cited by the Examiner. Claims 1-35 are also submitted to be patentable over the Examiner's proposed combination. In particular, since neither LEE et al. nor WEBER et al. disclose the features recited in Applicant's claims 1-35, the combination cannot disclose or teach the recited combinations of features. Thus, claims 1-33 are clearly distinguished over the combination of LEE et al. and WEBER et al.

Regarding the provisional rejection under the judicially created doctrine of obviousness-type double patenting, neither the claims in the present application or in the co-pending application are in their final form (i.e., have not been indicated to be allowable).

Moreover, Applicant submits that the respective claims are distinct from each other. The Examiner has set forth no proper evidentiary basis for his conclusion of obviousness.

Nevertheless, Applicant will consider filing a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) to obviate the judicially created double patenting rejection upon an indication of the allowability of the pending claims in the present application upon such filing.

Applicant further wishes to make of record a personal interview conducted between Applicant's undersigned representative and Examiner Lee on January 25, 2005 in regard to co-pending Application No. 10/767,615. The above-noted interview was attended by the undersigned representative of Applicant's assignee as well as Mr. Hiroshi Takahashi of Panasonic Communications Co., Ltd., the assignee of the present application.

Initially, Applicant wishes to thank Examiner Lee for his courtesy and cooperation in scheduling and conducting the above-noted interview. Applicant further wishes to thank the Examiner for his cooperative and positive attitude towards the interview and towards the invention defined in the present application.

During the above-noted interview, Applicant discussed the then outstanding objection and rejection in U.S. Patent Application No. 10/767,615.

During the above-noted interview, Applicant also noted for the Examiner that the present application is one of 15 continuation applications that all claim priority under 35 U.S.C. § 120 from parent U.S. Patent Application No. 09/461,402, which is now U.S. Patent No. 6,710,894 which issued on March 23, 2004.

Additionally, during the above-noted interview, Applicant presented the Examiner with a chart listing the 15 continuation applications and pointing out the differences between the subject matter to which the claims of each of the 15 continuations (as well as the parent) were directed. Applicant prepared and gave this chart to the Examiner to facilitate examination of all the continuation applications.

Applicant's representative also pointed out that since the subject matter of each of the applications is directed to a different aspect (or combination of aspects) of the present invention, Applicant does not believe that any type of obviousness type double patenting rejection is appropriate. However, Applicant respectfully requested that the Examiner consider the claims of all of these applications together to determine for himself whether a obviousness type double patenting rejection is appropriate. Applicant further indicated that if the Examiner decides that such a rejection is indicated, he would consider filing a Terminal Disclaimer to overcome such rejection.

Additionally, during the above-noted interview, Applicant's representative discussed several of the documents cited in the Information Disclosure Statements filed in the present application. In this regard, Applicant noted and expressly directed the Examiner's attention to Japanese Laid-Open Patent Publication HEI 10-307769, that issued to the Assignee of the present application and to Japanese Laid-Open Patent Publication HEI 08-542326 to Matsushita Electric Industrial Co., Ltd.

Applicant pointed out that both of these documents relate to the general subject matter of returning an error message which is claimed in several of the co-pending and commonly assigned continuation applications discussed above.

An English language translation and an English language patent family member of the above-noted Japanese documents (filed together with the Information Disclosure Statement) were also brought to the Examiner's attention and portions of the English language translation and patent family member were noted to relate to return of an error message. The Examiner particularly noted portions of the translation and family member that discuss the feature of returning an error message.

Applicant further respectfully suggested that in view of the discussion of the subject matter of various ones of the continuation applications, it would be obviously efficient to conduct examination of these 15 applications within a short time period after the interview in the present application.

At the conclusion of the interview, Applicant's undersigned representative expressed his appreciation to the Examiner for taking the time out of his busy schedule to conduct an extensive interview regarding the present application as well as regarding the co-pending applications. Applicant again thanks the Examiner for his courtesy as well as for his positive and cooperative nature as exhibited during the above-noted interview.

Applicant further wishes to make of record a telephone interview conducted on November 3, 2005 in co-pending Application No. 10/767,719. During the above-noted interview, Applicant's undersigned representative discussed the merits of the above-noted application, which, as has been previously pointed out to the Examiner, and as the Examiner is undoubtedly aware, is one of 15 continuations of parent Application No. 09/461,402, now U.S. Patent No. 6,710,894. During the interview, Applicant also noted that each of the above-noted continuations as well as the above-noted parent

application are being examined by the same Examiner. During the above-noted interview, the Examiner indicated that he is aware of each of the applications and the various references of record therein. Also during the above-noted interview, Applicant's undersigned representative asked the Examiner to ensure that the record is complete in each of these 15 applications by cross-citing each of the references cited in any of these applications into each of the other applications. The Examiner agreed to do so and Applicant agreed to facilitate such cross-citation by periodically updating the references cited in these various applications by the Examiner.

Accordingly, attached to the present Response, Applicant is providing a PTO-1449 Form in which various references cited in recently issued Office Actions in various ones of these 15 continuation applications are listed. The Examiner is respectfully requested to initial the attached PTO-1449 Form to confirm consideration of these documents. The Examiner is respectfully thanked for his cooperation in this matter which will enable the record in the present application to be complete and to accurately indicate that the Examiner has considered all of these references that were cited in individual ones of these applications with respect to the claims in each of the applications.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection and an indication of the allowability of all the claims pending in the present application, in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for consideration by the Examiner. With respect to the rejected claims, Applicant has pointed out the features thereof and has contrasted the features of the rejected claims with the disclosure of the references. Applicant has traversed the judicially created double patenting rejection but has indicated that he will consider filing a Terminal Disclaimer when the pending claims are otherwise indicated to be allowable. Applicant has also made of record a personal and a telephone interview.

Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Commissioner determine that an extension of time is required in order to render this response timely and/or complete, a formal request for an extension of time, under 37 C.F.R. §1.136(a), is herewith made in an amount equal to the time period required to render this response timely and/or complete. The Commissioner is authorized to charge any required extension of time fee under 37 C.F.R. §1.17 to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Hidehiko OGAWA



Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33630

January 5, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191